

REMARKS

I. Introduction

With the cancellation herein of claim 28, claims 23 to 27 and 29 are currently pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

II. Objection to the Specification

The Specification was objected to as assertedly failing to describe features of claim 26. Applicants respectfully traverse this assertion. For example, the Specification describes figure 4c, which shows a search results page that includes a first section providing a synopsis of a searched program, which is information regarding the search that is applicable to any of the distribution source types that provides the program and that further includes separate sections, each corresponding to a respective distribution source type.

The Specification was further objected to as assertedly failing to describe features of claim 27. Applicants respectfully traverse this assertion. For example, the Specification, e.g., at page 9, lines 8 to 16, describes responding to a request for suggested media content in accordance with user histories including a user's viewing habits, previous user-entered search criteria, past purchases, and/or past activity on a computer or set-top box.

Moreover, there is no requirement for the Specification to describe the features of the claims using the exact terms used in the claims. As stated by the Board in *Ex parte Sorenson*, 3 U.S.P.Q. 2d 1462, 1463 (Bd. Pat. App. Int. 1987) (emphasis added):

[W]e are mindful that appellant's specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. *The test is whether the originally filed specification disclosure reasonably conveys to a person having ordinary skill that applicant had possession of the subject matter later claimed. . . .*

Withdrawal of the objection to the Specification is therefore respectfully requested.

III. Rejection of Claims 26 to 28 Under 35 U.S.C. § 112, ¶ 1

Claims 26 to 28 stand rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the written description requirement.

As an initial matter, claim 28 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 28.

As to claims 26 and 27, *the Office bears the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.”* (See M.P.E.P. § 2163.04 (citing *In re Wertheim* 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). In particular, the Manual of Patent Examining Procedure specifically provides that if the Office rejects a claim based on the lack of a written description, the examiner should “identify the claim limitation not described” and also provide “*reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.*” (See *id.*).

It is respectfully submitted that the Office Action’s conclusory assertions simply do not identify why the rejected claims are not supported by the written description of the present application (and its specification) — which they plainly are, as explained above.

As stated by the Board in *Ex parte Harvey*, 3 U.S.P.Q. 2d 1626, 1627 (Bd. Pat. App. Int. 1986) (emphasis added, citations omitted):

Compliance with the written description requirement of Section 112 only requires that appellant’s application contain sufficient disclosure, *expressly or inherently*, to make it clear to persons skilled in the art that appellant possessed the subject matter claimed. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter, *rather than the presence or absence of literal support in the specification for the claimed language.*

Likewise, as stated by the Board in *Ex parte Sorenson*, 3 U.S.P.Q. 2d 1462, 1463 (Bd. Pat. App. Int. 1987) (emphasis added):

[W]e are mindful that appellant’s specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. *The test is whether the originally filed specification disclosure reasonably conveys to a person having ordinary skill that applicant had possession of the subject matter later claimed. . . .* Moreover, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the

art would not recognize in appellant's specification disclosure a description of the invention defined by the claims.

In particular, the *Sorenson* Board, noting that the examiner only essentially stated that the claim expressions at issue did not "appear in the original disclosure" and that the claim expressions were therefore "not adequately supported by the few specific compounds in the specification," found that the examiner had not met his initial burden of "presenting evidence why a person having ordinary skill in the art would not recognize in appellant's specification a description of the invention defined by the claims" — and that the "only reasoning presented" that the Board could discern was an "example of *ipse dixit* reasoning, resting on a bare assertion by the Examiner."

In view of all of the foregoing, it is respectfully submitted that the Office Action's conclusory assertions do not satisfy the evidentiary and judicial standards discussed above, and it is respectfully submitted that the Office Action does not establish a *prima facie* written description case with respect to the present application.

Furthermore, one skilled in the art would understand that the features of claims 26 and 27 are described in the Specification, e.g., in the portion describing figure 4c and at page 9, lines 8 to 16, as explained above.

It is therefore respectfully submitted that the present application does satisfy the written description requirement of 35 U.S.C. § 112.

Withdrawal of this written description rejection is therefore respectfully requested.

IV. Rejection of Claims 19 and 22 Under 35 U.S.C. § 112, ¶ 2

Claims 19 and 22 stand rejected under 35 U.S.C. § 112, ¶ 2 as assertedly indefinite. While Applicants do not agree with the merits of this rejection, claim 19 has been amended herein without prejudice, thereby rendering moot the present rejection. Withdrawal of this indefiniteness rejection is therefore respectfully requested.

V. Rejection of Claims 1 to 28 Under 35 U.S.C. § 103

Claims 1 to 28 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of U.S. Patent Application Publication No. 2003/0208767 (“Williamson et al.”) and U.S. Patent Application Publication No. 2004/0003097 (“Willis et al.”). It is respectfully submitted that the combination of Williamson et al. and Willis et al. does not render unpatentable any of the present claims for at least the following reasons.

As an initial matter, claim 28 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 28.

As for claims 1 to 27, to reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). As clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As explained herein, the Office Action does satisfy these requirements as to all of the features of the claims.

Each of claims 1, 18, and 19 recites, *inter alia*, the following:

. . . receiving from a user a user profile which identifies preferred media distribution sources . . . searching a plurality of media distribution source types for media content based on the at least one search criteria and the user profile . . . generating, from results of the searching, a schedule including scheduling information regarding the media content; and displaying the schedule to the user.

Thus, claims 1, 18, and 19 provide novel and counter-intuitive features in which, in response to a search request, a schedule is generated including scheduling information regarding media content from a plurality of media distribution source types, which, it is noted, often are scheduled in different manners. For example, movie theatre schedules include gaps as compared to TV program schedules which are, for the most part, continuous. Neither Williamson et al. nor Willis et al., whether considered alone or in combination, disclose or suggest these features.

The Office Action admits that Williamson et al. do not disclose searching a plurality of media distribution source types for media content based on search criteria and a user profile, and instead refers to Willis et al. as assertedly disclosing searching for content from a plurality of media distribution source types.

However, as explained in Applicants' previous Responses, Willis et al. provide a portal type system in which user preferences are used for filtering articles from different sources. The articles are provided to the user in a portal setting in which the different article categories are presented in different frames. In order to perform the filtering, a content generator generates for each obtained article a new version including searchable metadata. Subsequently, a content based router 130 filters the articles in accordance with user preferences and accordingly displays the articles in the portal. *See Willis et al.*, e.g., pars. 0085 – 0096. Willis et al. do not disclose or suggest generating a schedule based on the filtered articles. Further, Willis et al. do not disclose providing its portal information responsive to search criteria. Instead, obtained articles are sorted based on a set of user preferences. The different articles are determined to be relevant based on different ones of the set of preferences and are provided without regard to particular search criteria.

With respect to the feature of providing a schedule, the Office Action appears to rely on Williamson et al. as assertedly disclosing this feature. However, as the Office Action admits and as noted above, a schedule provided by Williamson et al. are not of results of a search of a plurality of media distribution source types. Even if the system of Williamson et al. would be modified based on the features of Willis et al. of providing a portal page including data from multiple distribution sources, the modified system would at most provide a portal in which obtained articles, one of which may include a television program schedule, are filtered in accordance with user preferences and then provided to the user in portal frames in accordance with the information category to which the obtained articles belong. The modified system would not disclose or suggest the features of any of claims 1, 18, and 19, particularly, the features of generating a schedule in response to a search

request, where the schedule includes scheduling information of results obtained from searching a plurality of media distribution source types.

The applied references do not include any suggestion to further modify the system to provide the features of claims 1, 18, and 19 according to which, in response to a search request, a schedule is generated including scheduling information regarding media content from a plurality of media distribution source types, which, as noted above, often are scheduled in different manners. Therefore, one skilled in the art would not arrive at the features of any of claims 1, 18, and 19 based on the combination of Williamson et al. and Willis et al. without an improper hindsight reconstruction based on Applicants' disclosure.

Accordingly, the combination of Williamson et al. and Willis et al. does not render unpatentable any of claims 1, 18, and 19.

Claim 16 includes subject matter analogous to that of claims 1, 18, and 19 and is therefore patentable for at least the same reasons set forth above in support of the patentability of claims 1, 18, and 19.

As for claims 2 to 15, 20, and 23 to 25 which ultimately depend from claim 1 and therefore include all of the features recited in claim 1, it is respectfully submitted that the combination of Williamson et al. and Willis et al. does not render unpatentable these dependent claims for the same reasons set forth above in support of the patentability of claim 1. *In re Fine, supra* (any dependent claim that depends from a non-obvious independent claim is non-obvious).

As further regards claim 23, the claim recites "generating . . . an intermediate results page including a plurality of media content titles . . . wherein the schedule is generated responsive to a selection of one of the titles of the intermediate results page and includes scheduling information exclusively regarding the selected title." None of the cited sections (or any other section) of Williamson et al. or Willis et al. disclose or suggest a schedule including scheduling information exclusively regarding a selected title. Further, claim 23 has been amended to recite that the schedule includes scheduling information pertaining to multiple ones of the plurality of media distribution source types. The cited references do not disclose scheduling information regarding a selected title that pertains to multiple media distribution source types. For these additional reasons, the combination of Williamson et al. and Willis et al. does not disclose or suggest all of the features of claim 23, and therefore does not render unpatentable claim 23 for these additional reasons.

As further regards claim 25, the claim recites that "the user profile identifies, for each of a plurality of source types, respective preferred media distribution sources." The

Office Action refers to pars. 0084 and 0102 of Williamson et al. as assertedly disclosing this feature. The cited sections of Williamson et al. are unrelated to preferred media distribution sources. Moreover, the Office Action apparently intends to refer to currently broadcast and upcoming programs as disclosing a plurality of source types. However, the cited sections of Williamson et al. do not disclose identification of respective preferred distribution sources for the currently broadcast programs and upcoming programs. For this additional reason, the combination of Williamson et al. and Willis et al. does not disclose or suggest all of the features of claim 25, and therefore does not render unpatentable claim 25 for this additional reason.

As for claim 17, which depends from claim 16 and therefore includes all of the features recited in claim 16, it is respectfully submitted that the combination of Williamson et al. and Willis et al. does not render unpatentable this dependent claim for the same reasons set forth above in support of the patentability of claim 16. *Id.*

As for claim 21, which depends from claim 18 and therefore includes all of the features recited in claim 18, it is respectfully submitted that the combination of Williamson et al. and Willis et al. does not render unpatentable this dependent claim for the same reasons set forth above in support of the patentability of claim 18. *Id.*

As for claim 22, which depends from claim 19 and therefore includes all of the features recited in claim 19, it is respectfully submitted that the combination of Williamson et al. and Willis et al. does not render unpatentable this dependent claim for the same reasons set forth above in support of the patentability of claim 19. *Id.*

Claim 26 relates to a method for searching for media content and recites, *inter alia*, the following:

... generating, from results of the searching, a results page including a first section having information of the results that applies to all of the media distribution source types from which the results were obtained, and, for each of the media distribution source types from which the results were obtained, a respective second section having all of the results obtained from the respective media distribution source type.

The Office Action refers to sections 820 and 860 of figure 8 of Willis et al. as assertedly disclosing the recited first and second sections, respectively. However, Applicants fail to understand how section 820 is considered to include information of results that applies to all media distribution source types, while section 860 is considered to include information of results obtained from a respective one of the media distribution source types. Instead, it appears that section 820 includes information obtained from one source, while section 860

includes information obtained from a different source. Further, what the Office Action intends to refer to as assertedly disclosing a media distribution source type for which the section 860 is provided is also not apparent.

Indeed, it is respectfully submitted that the combination of Williamson et al. and Willis et al. does not disclose or suggest these features, so that the combination of Williamson et al. and Willis et al. does not render unpatentable claim 26.

Claim 27, which has been amended herein without prejudice to include subject matter of canceled claim 28, relates to a method for searching for media content and recites, *inter alia*, the following:

. . . responsive to a request for media content suggestions, periodically: searching for media content of a plurality of media distribution source types, the searching being in accordance with at least one of a user viewing history and a user purchase history.

The Office Action refers to par. 0084 of Williamson et al. as assertedly disclosing a viewing history. The cited section refers to categorization of a user's reserved programs and is unrelated to a viewing history. The Office Action refers to pars. 0093 and 0097 of Williamson et al. as assertedly disclosing a user purchase history. While the cited sections may refer generally to providing access to programs for purchase, the cited sections do not disclose or suggest searching for content in accordance with a purchase history.

Accordingly, the combination of Williamson et al. and Willis et al. does not disclose or suggest all of the features of claim 27, so that the combination of Williamson et al. and Willis et al. does not render unpatentable claim 27.

Withdrawal of this obviousness rejection is therefore respectfully requested.

VI. Rejection of Claim 29 Under 35 U.S.C. § 103

Claim 29 stands rejected under 35 U.S.C. § 103 as unpatentable over the combination of Williamson et al., Willis et al., and U.S. Patent Application Publication No. 2002/0078382 ("Sheikh"). It is respectfully submitted that the combination of Williamson et al., Willis et al., and Sheikh does not render unpatentable claim 29 for at least the following reasons.

Claim 29 includes subject matter analogous to that of claim 1 and is therefore allowable for at least essentially the same reasons as claim 1, since Sheikh does not correct the critical deficiencies of the combination of Williamson et al. and Willis et al. noted above in support of the patentability of claim 1.

Furthermore, claim 29 relates to a method for searching for media content and, as herein amended without prejudice, recites, *inter alia*, the following:

*. . . if the searching [based on the at least one search criteria and the user profile including based on the identification of the preferred media distribution sources of the user profile] returns results:
generating, from the results of the searching, a schedule including scheduling information regarding the media content of the returned results; and
displaying the schedule to the user; and
if the searching does not return any results:
periodically searching the plurality of media distribution source types for media content, the periodic searching being unconstrained by at least one of the at least one search criteria, the user profile, and the identification of the preferred media distribution sources of the user profile . . .*

Thus, claim 29 provides for repeating a search using different criteria if the search initially does not return results. The Office Action refers to par. 0053 of Sheikh as assertedly disclosing the feature of “if the searching does not return any results: periodically searching the plurality of . . . types for media content, the periodic searching being unconstrained” However, Sheikh merely indicates that, if no result is returned, a sensor is re-executed. Thus, the combination of Williamson et al., Willis et al., and Sheikh does not disclose or suggest all of the features of claim 29 for this additional reason, so that the combination of Williamson et al., Willis et al., and Sheikh does not render unpatentable claim 29 for this additional reason.

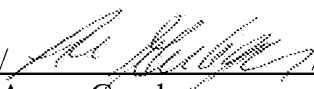
Withdrawal of this obviousness rejection is therefore respectfully requested.

VII. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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